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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,990	11/25/2003	Andrew Arthur Gooley	FBR 20.750 (031035-00062)	7983
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KATTEN MUCHIN ROSENMAN LLP			NAGPAUL, JYOTI	
575 MADISON AVENUE			ART UNIT	PAPER NUMBER
NEW YORK, NY 10022-2585			1797	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/723,990

Applicant(s)

GOOLEY ET AL.

Examiner

Jyoti Nagpaul

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “wherein a reservoir is connected to the moveable head by a single tube for supplying liquid to at least one displacement means” as recited in claims 5 and 13 and “clutch means” as recited in Claim 8 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-4, 8 and 10** are rejected under 35 U.S.C. 102(b) as being anticipated by Soulier (FR2148705).

Soulier teaches an apparatus of handling of liquid samples for chemical, biochemical and/or histological analysis. The apparatus comprises at least one cutting head/punch of perforation mounted on a apparatus (10) for movement in X, Y and Z directions by an automated control system for excising a sample from the array. (See Figures 1-10) (See abstract) The apparatus further comprises one or more liquid aspiration and delivery outlet means/pipette for dispensing liquids onto the array of samples and a movable head (80) mounted on an automated motion control system for controlling movement of the moveable head in X, Y, and Z directions. The apparatus further comprises at least one displacement means/syringe (103) connected to a liquid supply means and to one or more of the liquid aspiration and delivery outlet means/pipette via a valve means for causing the dispensing of liquid from the one or more liquid aspiration and delivery outlet means. (See Figures 7-8) The at least one displacement means/syringe and the one or more liquid aspiration and delivery outlet means/pipette are carried by the moveable head. (See Figures 1-10) The device

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further comprises a plurality of syringes mounted in parallel on the movable head. (See Figure 7) The syringes (103) and the outlets are mounted on opposite sides on an axis of movement of the apparatus along which the movable head is arranged to travel. (See Figure 8)

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claims 5-7, 9, and 11-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Soulier in view of Scatizzi (EP 0945728).

Refer above for the teachings of Soulier.

Soulier fails to teach wherein a reservoir is connected to the moveable head by a single tube for supplying liquid to at least one displacement means and wherein eight or more syringes are mounted along parallel axes which, in use, are generally vertically oriented. Soulier further fails to teach one or more valves are provided for controlling the flow of liquid to and from the syringes. Soulier further fails to explicitly teach that the device for dispensing liquids is located on the same movable head as the at least one cutting head.

Scatizzi teaches an apparatus for the controlled withdrawal and delivery of volumetrically metered liquids. The apparatus comprises a reservoir (35) is connected to the moveable head by a single tube (32) for supplying liquid to at least one displacement means. (See Figure 1) Scatizzi further teaches one or more valves are provided for controlling the flow of liquid to and from the syringes.

It would have been obvious to one having ordinary skill in the art to provide a reservoir connected to the moveable head of Soulier by a single tube for supplying liquid to at least one displacement to achieve the predictable results of providing cleaning liquid to the syringe and thus prevent contamination of liquid samples.

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It would have been obvious to one having ordinary skill in the art to provide eight of more syringes to achieve the predictable results of increasing through put through the system.

The combination of known elements into a single device by mounting them on a single device is conventionally known in the art. It would have been obvious to one having ordinary skill in the art to provide a device for dispensing liquids is located on the same movable head as the at least one cutting head to achieve the predictable results of increasing the efficiency of the overall process.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jyoti Nagpaul whose telephone number is 571-272-1273. The examiner can normally be reached on Monday thru Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JN


Jill Warden
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